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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,312	07/10/2003	Pijush K. Dewanjee	PU2162	1311
23454	7590	09/20/2004	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			PASSANITI, SEBASTIANO	
		ART UNIT	PAPER NUMBER	
		3711		

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

7N

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/604,312	DEWANJEE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Sebastiano Passaniti	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on see detailed Office action.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/10/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

This Office action is responsive to communication received 07/10/2003 – application papers filed.

This application is a CIP of 09/693,349, filed 10/20/2000, now U.S. Patent No. 6,632,391, which is a DIVISIONAL of 09/389,798, filed 09/03/1999, now U.S. Patent No. 6,238,302.

Claims 1-19 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 6, 10 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowland in view of Hettinger and Gojny. At the outset, it is noted that the filing date of the Rowland reference predates applicant's earliest priority date. Thus, the reference is available as prior art under §102(e) and therefore may be used

under §103(a). The patent to Rowland shows every feature claimed with the exception of a composite polyurethane material for the striking face insert. Hettinger and Gojny show it to be old in the art to provide a composite insert for the striking face portion of a club head in order to provide additional energy to a struck ball. See col. 4, lines 45-55 in Hettinger. See col. 1, lines 35-46 and col. 2, lines 35-45 in Gojny. In view of the patents to Hettinger and Gojny, it would have been obvious to modify the device in the cited art reference to Rowland by replacing the insert with a material that is composed of thermoplastic polyurethane, the motivation being to alter the ball striking characteristics of the face. Moreover, it is noted that Rowland suggests that other materials may be used as part of the striking face in order to change the impact force as well as the corresponding trajectory and the amount of ball spin (col. 5, lines 14-20). As for the remaining claimed limitations and specific to claims 2-4, note Figure 16 showing a plurality of tabs. An adhesive may be used to affix the insert within the recess in the striking face (col. 5, lines 21-33). As to claim 6, the claimed thermoplastic polyurethane materials are merely examples of thermoplastic materials that are commonly available. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired. As to claim 9, the insert in Rowland includes a trapezoidal shape. As to claim 10, see Figure 9 in Rowland showing the depth of the recess in the front of the striking face. As to claim 12, note again the language in col. 5, lines 20-33 in Rowland. As to claim 13, Figure 16 clearly shows a plurality of straight and curved portions. As to claims 14-17,

the claimed limitations are not deemed critical. As to claims 18 and 19, note the comments for claims 1, 2 and 6, supra.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowland in view of Hettinger, Gojny, Kim and Saeki. Rowland in view of Hettinger and Gojny has been discussed above. Rowland, as modified, lacks a coating on the face. Saeki and Kim both show it to be old in the art to provide the face of a club head with a coating. In the case of Saeki, the coating serves to help prevent rust. In Kim, the coating helps to alter the ball flying characteristics of a struck ball. In view of the patents to Saeki and Kim, it would have been obvious to modify the device in the cited art reference to Rowland by providing a coating to the insert, the motivation being to help protect the insert from the natural elements or to simply change the ball striking characteristics of the insert.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No.

6,238,302 in view of Hettinger and Gojny. The claimed invention of the '302 Patent differs from the instant claimed invention in that the claimed invention of the '302 Patent does not require a thermoplastic polyurethane material. Instead, the claimed invention of the '302 Patent requires, in some instances, the use of a thermoset polymer material. Hettinger and Gojny show it to be old in the art to provide a composite insert for the striking face portion of a club head in order to provide additional energy to a struck ball. See col. 4, lines 45-55 in Hettinger. See col. 1, lines 35-46 and col. 2, lines 35-45 in Gojny. In view of the patents to Hettinger and Gojny, it would have been obvious to modify the claimed device in the '302 Patent by replacing the insert with a material that is composed of thermoplastic polyurethane, the motivation being to alter the ball striking characteristics of the face. With respect to the remaining claimed limitations, note the following:

As to instant claim 1, see claim 1 of the '302 Patent.

As to instant claim 2, see claim 1 of the '302 Patent.

As to instant claim 3, see claim 3 of the '302 Patent.

As to instant claim 4, see claim 4 of the '302 Patent.

As to instant claim 5, see claim 1 of the '302 Patent.

As to instant claim 6, the claimed thermoplastic polyurethane materials are merely examples of thermoplastic materials that are commonly available. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired.

As to instant claim 7, see claim 6 of the '302 Patent.

As to instant claim 8, see claims 1 and 14 of the '302 Patent.

As to instant claim 9, see claim 7 of the '302 Patent.

As to instant claim 10, see claim 15 of the '302 Patent.

As to instant claim 11, see claim 15 of the '302 Patent.

As to instant claim 12, see claim 16 of the '302 Patent.

As to instant claim 13, see claim 1 of the '302 Patent.

As to instant claim 14, see claim 10 of the '302 Patent.

As to instant claim 15, see claim 11 of the '302 Patent.

As to instant claim 16, see claim 12 of the '302 Patent.

As to instant claim 17, see claim 13 of the '302 Patent.

As to instant claim 18, see claim 15 of the '302 Patent along with an explanation of the modification of the '302 claimed invention in view of Hettinger and Gojny, as outlined supra.

As to instant claim 19, the claimed thermoplastic polyurethane materials are merely examples of thermoplastic materials that are commonly available. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired.

Enclosed with this Office action is a sample terminal disclaimer, which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel \_\_\_\_\_, Frame \_\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From: \_\_\_\_\_ To: \_\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Su shows an insert assembly, of interest. Fisher ('132) shows materials for the striking face, of interest.

In addition to those references cited herein above, all references cited during the prosecution of applicant's parent application serial nos. 09/389,798 and 09/693,349 are deemed pertinent to this instant application and are hereby incorporated by reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Pasaniti/sp  
September 14, 2004

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: \_\_\_\_\_

Application No.: \_\_\_\_\_ Filed: \_\_\_\_\_

For: \_\_\_\_\_

, a \_\_\_\_\_

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

- A.  An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

- B.  A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

Additional documents in the chain of title are listed on a supplemental sheet.

Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : \_\_\_\_\_

Name : \_\_\_\_\_

Title : \_\_\_\_\_

Signature: \_\_\_\_\_

## MANUAL OF PATENT EXAMINING PROCEDURE

PTO/SB/26 (10-00)

Approved for use 10/31/2002, OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT</b>	Docket Number (Optional)
--	--------------------------

In re Application of:

Application No.:

Filed:

For:

The owner\*, \_\_\_\_\_, of \_\_\_\_\_ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. \_\_\_\_\_. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1.  For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2.  The undersigned is an attorney or agent of record.

Signature

Date

Typed or printed name

- Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.